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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,298	03/14/2001	Christopher Donald Johnson	17243-00009	9617

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EXAMINER

COLON, CATHERINE M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,298

Applicant(s)

JOHNSON ET AL.

Examiner

C. Michelle Colon

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a Final Office Action in response to the communication received on April 13, 2005. Claims 1, 4, 5, 7, 11, 13, 17, 19, 23, 25, 29, 31, 35, 37, 47 and 56 have been amended. Claim 30 has been canceled. Claim 59 has been added. Claims 1-29 and 31-59 are now pending in this application.

Response to Amendment

2. Applicant's amendments to claims 1, 4, 5, 7, 11, 13, 17, 19, 23, 25, 29, 31, 35, 37, 47 and 56 are acknowledged. The cancellation of claim 30 is acknowledged. The addition of claim 59 is acknowledged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The relationship between underwriting in a cash manner and the generation of value tables is unclear. More specifically, it is unclear how underwriting in a full cash manner is used to generate a full value table and how underwriting in a partial cash manner is used to generate a partial value table, in particular, since underwriting in a cash manner as well as value tables have not been and are not recited elsewhere in the claims. Additionally, it is unclear what steps are

necessary for underwriting in a cash manner to generate value tables. For examination purposes, Examiner is interpreting the limitation as evaluating cash flows as another type of asset.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-29 and 31-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marpe et al. (U.S. 6,671,693) and Hartnett (U.S. 6,112,188).

As per claims 1, 13 and 25, Marpe et al. discloses a method, system and computer for collaborating on due diligence issues to affect efficient knowledge building within due diligence teams using a computer system coupled to a data repository, said method comprising the steps of:

accessing stored, accumulated knowledge in a repository from prior due diligence exercises (col. 13, lines 50-61; items 1302 and 1312 in Figure 13; The system allows users to access data from a database, where the data is knowledge accumulated from past exercises. Users access the knowledge database via an interface called the Navigation Chevron.);

conducting a current due diligence exercise (col. 53, lines 12-30; The system allows users to actively conduct strategic, financial and legal due diligence.);

applying the accumulated knowledge from past due diligence exercises to the current due diligence exercise (col. 15, lines 49-59; col. 15, line 64-col. 16, line 16; Users use data from past projects found in the knowledge base to conduct their current projects.); and

storing newly accumulated knowledge from the current due diligence exercise into the data repository of accumulated knowledge (col. 15, lines 49-59; col. 17, lines 2-15; Users can add knowledge to the knowledge database as they complete new projects.).

Marpe also teaches an industry solution pack that contains a knowledge database of data such as key financial activities and proven practices for performing financial due diligence and underwriting (col. 51, lines 54-57; col. 52, lines 41 and 47; col. 53, line 25).

Marpe does not expressly disclose valuating assets in a portfolio individually and collectively by segmenting the portfolio of assets into three valuation portions and by underwriting each asset individually included within a first portion of the asset portfolio, grouping and underwriting a sample of assets included within a second portion of the asset portfolio, and using the computer to statistically infer a value for assets included within a third portion of the asset portfolio. Hartnett discloses valuating assets in a portfolio individually and collectively by segmenting the portfolio of assets into three valuation portions and by

underwriting each asset individually included within a first portion of the asset portfolio (col. 27, lines 25-32; col. 48, lines 13-20; col. 60, line 13; col. 61, lines 19, 29

and 39; Assets are segmented within a portfolio into several portions/categories based on their asset type such as cash, stock, debt, foreign currency, annuity, etc., and then valuated based on their grouping.),

grouping and underwriting a sample of assets included within a second portion of the asset portfolio (col. 25, lines 60-63; col. 48, lines 13-20; Users simulate portfolio asset valuations using the privatize tool. Assets are valuated based on their type (i.e., portion/grouping they are in).), and

using the computer to statistically infer a value for assets included within a third portion of the asset portfolio (col. 30, lines 22-28; col. 48, lines 13-20; Asset valuations are based on the asset type (i.e., portion/grouping the asset is in). For example, stocks are valuated differently than annuities.).

Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of Marpe to valuate assets in a portfolio using the specific steps as taught by Hartnett because doing so would provide the system of Marpe with more asset valuation capabilities for its underwriting and financial due diligence solution pack, thereby providing users with an enhanced system with more underwriting and financial due diligence features and functionality.

As per claims 2, 14 and 26, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of accessing stored, accumulated knowledge in a repository further comprises the step of accessing a suite of at least one of business processes, computer systems, analytical tools, financial models, data manipulation tools, business process tools, methodologies and analytics

(col. 13, lines 18-61; col. 15, line 17; col. 16, lines 46-65; col. 17, lines 19-67; col. 40, lines 17-20; The system provides users with a suite of tools for carrying out various business functions.).

As per claims 3, 15 and 27, Marpe et al. discloses a method, system and computer according to claim 1, 13 and 25, wherein said step of accessing stored, accumulated knowledge in a repository further comprises the step of accessing a high level map and associated descriptions of the roles and responsibilities within the due diligence team such that team members can see who has functional responsibilities, how the team members as individuals fit into the due diligence team and who to contact for information (col. 43, line 55-col. 44, line 67).

As per claims 4, 16 and 28, Marpe et al. discloses a method, system and computer according to claim 1, 13 and 25, wherein said step of applying the accumulated knowledge from past due diligence exercises further comprises the step of accessing a due diligence project timeline with milestones and tasks arranged as at least one of Gantt charts, PERT charts and text such that key deliverable timing is developed at the beginning of the due diligence project with inputs from due diligence team members (col. 9, lines 35-52; col. 17, lines 33-67; col. 18, lines 12-24; col. 29, lines 45-65; Figure 8; The system allows users to create projects including project timelines, milestones and deliverables. Users also have access to past due diligence exercises via entire histories of the discussion database, from users who have already completed projects.).

As per claims 5, 17 and 29, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, further comprising the step of accessing a project feedback mechanism including graphical indicators for tracking key due diligence deliverables including at least one of types and quantities of underwriting completed, financial risk and return metric, total project budget and status of deliverables (col. 17, lines 37-60; col. 18, lines 41-47; col. 19, lines 35-47; The system tracks and reports on the progress of projects including status of milestones and deliverables.).

As per claims 6, 18 and 30, Marpe et al. discloses a method, system and computer according to claims 5, 17 and 29, wherein said step of accessing a project feedback mechanism further comprises the step of accessing a due diligence project calendar with notable local and global dates identified (col. 19, lines 30-47; col. 43, lines 54-55; Figures 9 and 10; The system provides the user with calendaring features.).

As per claims 7, 19 and 31, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, further comprising the step of storing contact information of due diligence team members and collaborators including at least one of telephone numbers, e-mail address and postal address information (col. 42, line 20-col. 43, line 29; The system allows users to create and store contact information.).

As per claims 8, 20 and 32, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, further comprising the step of storing a due diligence project to do list and status for items on the to do list (col. 21, line 32-col. 22,

line 61; col. 25, lines 15-25; The system allows users to maintain project task lists and the status related to the tasks.).

As per claims 9, 21 and 33, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of storing newly accumulated knowledge further comprises the step of creating a shared storage place for various due diligence functions to store project files and information such that team members and collaborators can access and retrieve the information (col. 2, lines 59-67; col. 9, lines 10-52; Figure 1).

As per claims 10, 22 and 34, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of storing newly accumulated knowledge further comprises the step of creating an information flow map that identifies sources and uses of information utilized to make due diligence decisions (col. 13, line 18-col. 14, line 14; The system provides users with a hierarchy of categories to easily identify and find the appropriate knowledge topic.).

As per claims 11, 23 and 35, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of accessing stored, accumulated knowledge further comprises the step of accessing historical best practices stored within the data repository generated from past due diligence exercises (col. 9, lines 50-52; col. 47, lines 5-42; Users have access to accumulated knowledge from past due diligence exercises via entire histories of the discussion database, from users who have already completed projects and who have submitted data relating to their experiences with the projects.).

As per claims 12, 24 and 36, Marpe et al. discloses a method, system and computer according to claims 1, 13 and 25, wherein said step of accessing stored, accumulated knowledge further comprises the step of accessing a database of relevant valuation information and facts associated with the due diligence to value a portfolio of assets (col. 51, line 9-col. 53, line 25; The system has industry-specific applications, including underwriting, valuation and financial due diligence functions.).

Claims 37-59 recite substantially similar limitations as claims 1-29 and 31-36 above. Therefore, claims 37-59 are rejected on the same basis as claims 1-29 and 31-36 above.

Response to Arguments

7. Applicant's arguments are based on the claims, as amended. Therefore, Applicant's arguments have been addressed above in the new grounds of rejections to the amended claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- King et al. (U.S. 5,704,045) discusses a system of risk diversification;
- Sandretto (U.S. 5,812,988) discusses a system and method for estimating cash flows, risk measures and present values for a plurality of assets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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communications labeled "Box AF"]

571-273-6727 [For status inquiries, draft communication, labeled
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Hand delivered responses should be brought to:

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Art Unit: 3623

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cmc
July 8, 2005


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